UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
2900 Crystal Drive
Arlington, Virginia 22202-3513

Baxley

Mailed: April 27, 2004

Opposition No. **91156666**
Opposition No. **91158331**

Optimize Technologies, Inc.

v.

Wicom GmbH

(as consolidated)

Andrew P. Baxley, Interlocutory Attorney:

Applicant's consented motion (filed March 2, 2004) to amend its answer in Opposition No. 91156666 is hereby granted. Applicant's amended answer is now its operative pleading in Opposition No. 91156666.

This case now comes up for consideration of opposer's motion (filed March 19, 2004) to consolidate the above-captioned proceedings.[1] Applicant has filed a brief in response thereto.[2]

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[1] Opposer's motion to consolidate lists only Opposition No. 91158331 in the caption thereof. Inasmuch as the motion to consolidate involved both of the above-captioned proceedings, both proceedings should have been set forth in the caption. Cf. TBMP Section 511.

[2] On April 19, 2004, opposer's counsel contacted the Board attorney assigned to these cases by telephone to inquire as to when the Board would issue a decision on its motion to consolidate. The Board attorney contacted applicant's attorney by telephone on April 20, 2004 to request that he transmit by facsimile a copy of its brief in connection with the motion to

The Board notes initially that the Board issued an order on March 12, 2004 wherein it suspended proceedings in Opposition No. 91156666 pending disposition of applicant's motion for leave to amend its answer, which was filed on the eve of trial in that proceeding. In the suspension order, the Board indicated that any paper that is not relevant to applicant's motion would receive no consideration. However, opposer served its motion to consolidate four days after the issuance of that order. Inasmuch as opposer's motion to consolidate and the Board's March 12, 2004 suspension order appear to have crossed in the mail, the Board will consider the motion to consolidate and applicant's response thereto.[3]

After reviewing the parties' arguments with regard to the motion to consolidate, the Board finds that consolidation of the proceedings is appropriate inasmuch as the parties are the same, the proceedings involve common questions of law or fact, and consolidation will save the

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consolidate. Applicant so transmitted its brief on April 23, 2004.

[3] Applicant's response to the motion to consolidate should have been filed not later than April 5, 2004. See Trademark Rules 2.119(e) and 2.127(a). However, because the March 12, 2004 suspension order may have caused applicant to believe that it could not respond to the motion to consolidate until proceedings were resumed, the Board will consider applicant's brief in response.

parties and the Board considerable time, effort and expense.[4] See TBMP Section 511.

In view thereof, opposer's motion to consolidate is granted to the extent modified herein. Opposition Nos. 91156666 and 91158331 are hereby consolidated.

The consolidated cases may be presented on the same record and briefs. See *Helene Curtis Industries Inc. v. Suave Shoe Corp.*, 13 USPQ2d 1618 (TTAB 1989) and *Hilson Research Inc. v. Society for Human Resource Management*, 26 USPQ2d 1423 (TTAB 1993).

In keeping with Board practice, the Board file will be maintained in Opposition No. 91156666 as the "parent" case. As a general rule, from this point on only a single copy of any paper or motion should be filed herein; but that copy should include both proceeding numbers in its caption. Exceptions to the general rule involve stipulated extensions of the trial dates, see Trademark Rule 2.121(d), and briefs on the case, see Trademark Rule 2.128.

Despite being consolidated, each proceeding retains its separate character. The decision on the consolidated cases shall take into account any differences in the issues raised

[4] When cases involving common questions of law or fact are pending before the Board, the Board may order the consolidation of the cases. *See* Fed. R. Civ. P. 42(a); *see also*, *Regatta Sport Ltd. v. Telux-Pioneer Inc.,* 20 USPQ2d 1154 (TTAB 1991) and *Estate of Biro v. Bic Corp.*, 18 USPQ2d 1382 (TTAB 1991).

by the respective pleading; a copy of the decision shall be placed in each proceeding file.

With regard to the schedule in these consolidated proceedings, the Board notes that these proceedings have been ripe for consolidation since applicant filed its answer in Opposition No. 91158331 on December 15, 2003; that discovery closed in Opposition No. 91156666 on January 5, 2004; and that the issue of consolidation was not raised until more than ten weeks after the close of discovery in Opposition No. 91156666. See Trademark Rule 2.196; TBMP Section 511. The Board further notes that the parties were told unequivocably in the Board orders instituting both proceedings that they should notify the Board "immediately" if they are also parties to other Board proceedings involving related marks or, during the pendency of this proceeding, they become parties to such proceedings so that the Board could consider consolidation of those proceedings. Opposition No. 91156666, June 17, 2003 order at 2; Opposition No. 91158331, November 4, 2003 order at 2.

In scheduling newly consolidated proceedings, the Board generally adopts the schedule of the most junior of the consolidated proceedings, provided that the consolidate proceedings are in the same procedural phase. While trial has not commenced in either proceeding, the consolidated proceedings are in different procedural phases in that

discovery has closed in Opposition No. 91156666, but remains open in Opposition No. 91158331.

The schedule that opposer has proposed for the consolidated proceedings would reopen discovery in Opposition No. 91156666. However, a reopening of discovery requires a showing of excusable neglect. See *Pioneer Investment Services Company v. Brunswick Associates Limited Partnership*, *supra*; *Pumpkin, Ltd. v. The Seed Corps*, *supra*; Fed. R. Civ. P. 6(b); TBMP Section 509.02. Opposer's motion to consolidate includes no such showing.[5] Accordingly, the Board finds that a general reopening of discovery in Opposition No. 91156666 is inappropriate. The Board, however, will reopen discovery in that proceeding for the limited purpose of taking discovery related to applicant's amended response to paragraph No. 6 of the notice of opposition which is set forth in applicant's amended answer.[6]

Proceedings in Opposition No. 91156666 are hereby resumed. Discovery in Opposition No. 91156666 is reopened for the limited purpose of taking discovery related to

[5] Indeed, opposer's brief in support of its motion to consolidate provides no explanation as to why the motion was not filed prior to the close of discovery in Opposition No. 91156666.

[6] Rather, if opposer, who as the plaintiff herein has the burden of proof, wished to have the consolidated proceedings move forward on a common discovery schedule, it should have filed its motion to consolidate prior to the close of discovery in

applicant's amended response to paragraph No. 6 of the notice of opposition which is set forth in applicant's amended answer and is hereby reset to close in accordance with the schedule set forth in the institution order for Opposition No. 91158331. The close of discovery in Opposition No. 91158331 remains as set. The trial dates for the consolidated proceedings remain as set forth in the institution order for Opposition No. 91158331, such dates being as follows.[7]

DISCOVERY PERIOD CLOSES:	**5/22/04**
Plaintiff's thirty-day testimony period to close:	**8/22/04**
Defendant's thirty-day testimony period to close:	**10/19/04**
Plaintiff's fifteen-day rebuttal period to close	**12/3/04**

In each instance, a copy of the transcript of testimony together with copies of documentary exhibits, must be served on the adverse party within thirty days after completion of the taking of testimony. Trademark Rule 2.l25.

Opposition No. 91156666, i.e., on or prior to January 5, 2004. See also TBMP Section 403.05 (2d ed. June 2003).

[7] Opposer is advised that proposed dates should not be included in an unconsented motion. The better practice is to request that dates be reset to run for a specific length from the mailing date of the Board's decision thereon. See TBMP Section 509.02. Further, the proposed scheduling order that opposer filed with its motion to consolidate is unnecessary.

The Board further notes that, if opposer wished to have this motion to consolidate resolved in an expedited manner, it should have sought to have that motion resolved by telephone conference shortly after filing such motion. See Trademark Rule 2.120(i)(1); TBMP Section 502.07(a).

Briefs shall be filed in accordance with Trademark Rule 2.128(a) and (b). An oral hearing will be set only upon request filed as provided by Trademark Rule 2.l29.